

Applicant : Wade *et al.*  
Serial No. : 10/783,713  
Filed : February 20, 2004  
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Attorney's Docket No.: 020859-003010US

## **REMARKS**

Claims 1-34 are pending in the Application

Claims 1-15, and 27-34 are withdrawn from consideration and cancelled without prejudice.

Claims 16-26 are rejected.

Claims 17, 20 and 23 are cancelled herein.

Claims 16, 18 and 24-26 are amended herein.

Claims 35-42 are added herein. No new matter is added by virtue of these additions. Support for these claims may be found in the Application at page 10, paragraphs 164 through 167.

Claims 16, 18-19, 21-22 and 24-26, and 35-42 are pending in the Application after entry of the amendments herein.

### **I. RESTRICTION UNDER 35 U.S.C. § 121**

The Examiner restricted the claims into three Groups. On March 3, 2008, Applicant responded to the Office Action having a mailing date of February 22, 2008 (“Restriction Requirement”), having a shortened statutory period for response set to expire on June 3, 2008, and elected to continue prosecution of Group II (Claims 16-26) without traverse. Claims 1-15 and 27-34 are withdrawn from consideration and have been cancelled herein without prejudice.

## **II. REJECTION UNDER 35 U.S.C. § 102(b) AS ANTICIPATED BY BALDESCHWIELER**

Examiner has rejected Claims 16-26 under 35 U.S.C. § 102(a) as being anticipated by Baldeschwieler *et al.*, U.S. Patent No. 5,824470 ("Baldeschwieler"). Office Action at 2.

Regarding rejections under 35 U.S.C. § 102(b), anticipation requires each and every element of the claim to be found within the cited prior art reference.

Regarding Claims 17, 20 and 23, these claims have been cancelled herein and therefore rejection of these claims is now moot.

Regarding Claim 16, this claim has been amended as follows:

A device comprising: a nanostructure having a surface; and a passivation layer coating all but a unique site on the surface, the unique site exhibiting at least one of chemical, biological, electrical, and physical activity, wherein the nanostructure comprises a carbon nanotube, wherein a material is attached to the unique site, and wherein a moveable probe is connected to the nanostructure.

Claim 16, as amended now requires that the unique site on the surface (of the carbon nanotube) have a material attached to it. *Baldeschwieler* does not teach or disclose attaching a material to a carbon nanotube. Therefore, Claim 16, as amended, is not anticipated by *Baldeschwieler*.

Regarding Claims 18 and 24-26, these claims have been amended herein to be dependent upon amended Claim 16. Claim 26 was further amended to delete "functional group" which has no antecedent basis in Claim 16 with "material" which has antecedent basis in Claim 16. In view of these amendments, Claims 18-19, 21-22 and 24-26 are dependent upon amended Claim 16, and are not anticipated by *Baldeschwieler* for the same reasons Claim 16, as amended, is not anticipated.

Therefore, in view of the foregoing, Applicant respectfully requests the Examiner to withdraw the rejection of Claims 16, 18-19, 21-22 and 24-26 under 35 U.S.C. § 102(b) as being anticipated by *Baldeschwieler*.

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### **III. NEW CLAIMS**

Applicant has added new Claims 35-42 into the instant Application. No new matter is added by the addition of these claims.

### **IV. CONCLUSION**

As a result of the foregoing, it is asserted by Applicant that the Claims in the Application are now in a condition for allowance, and respectfully requests allowance of such Claims.

Applicant believes that all fees due with the filing of this paper are being submitted herewith. However, should any additional fees be required, the Commissioner is authorized to charge such fees to Deposit Account No.20-1430. Please reference Attorney Docket No. **020859-003010US**.

Applicant respectfully requests that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

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Date: September 30, 2008

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